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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,845	11/21/2001	James E. Lerch JR.	011215	1251

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Eckert Seamans Cherin & Mellot, LLC
Alcoa Technical Center
100 Technical Drive
Alcoa Center, PA 15069-0001

EXAMINER

GARCIA, ERNESTO

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/989,845

Applicant(s)

LERCH, JAMES E.

Examiner

Ernesto Garcia

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-12, 14-16, 18-22 and 24 is/are pending in the application.
- 4a) Of the above claim(s) 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-12, 14-16, 18-20, 22 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Claim 21 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the election filed on 4/28/03. Claim 21 does not read on the elected species as the channel 5 is not U-shaped but rather T-shaped.

Claim Objections

Claims 4, 11, 22 and 24 are objected to because of the following informalities:
regarding claims 4 and 11, the limitation "each ... railing" in line 1 lacks proper antecedent basis as at least two or more extending railings have not been previously recited in claim 1, and "slot" should be --channel--;
regarding claim 22, the limitation "slot" in line 2 should be --channel--; and,
regarding claim 24, this claim depends from a cancelled claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 3679

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5, 7-12, 14-16 and 18-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention.

Regarding claims 1, 8 and 18, it is unclear what feature of the invention allows one of ordinary skill in the art to provide a variably selection elevation of the railing when the fastening means is slidably embraced within the T-shaped channel and extending through the perforation in the flange segment as recited in lines 14-16 of claim 1, lines 13-14 of claim 8, and in lines 14-15 of claim 18. From the examiner's perspective, the railings can only be adjusted horizontally to a ground when the fastening means (the bolt) is loosen. Thereafter, the railing is fixed to the posts.

Regarding claims 2-5 and 7, the claims depend from claim 1 and therefore are not enabled to use the invention.

Regarding claims 8-12 and 14-16, the claims depend from claim 8 and therefore are not enabled to use the invention.

Regarding claims 14-16, the claims depend from claim 18 and therefore are not enabled to use the invention.

Claims 8-12 and 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 8, the limitation "variably select" is unclear as the meets and bounds as to what constitutes "variably select" when associated with the figures. The drawings only show each railing fixed at predetermined heights which are not variable in elevation but rather in a longitudinal direction.

Regarding claims 9-12 and 14-16, the claims directly or indirectly depend from claim 8 and therefore are indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3679

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 8-10 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Case, 3,388,892 (see reproduced marked-up attachment).

Regarding claim 1, Case discloses an improvement, in a barrier, comprising at least one longitudinally extending railing **82**, vertically extending posts **56**, and fastening means **42c**.

The railing **82** has at least one generally T-shaped channel **86**. The channel **86** extends in a longitudinal direction **A3** of the railing **82** and at least one leg **A12** of the channel **86** extends inwardly within the channel **86**.

The posts **56** each have an elongated body **A5** and at least two flange segments **58**. The flange segments **58** extend outwardly in opposite directions **A7** and have at least one perforation **71** in each of the flange segments **58**.

The fastening means **42c** are slidably embraced within the channel **86** and the fastening means **42c** extend through the perforation **71** in the flange segments **58** and fastened to the posts **56** to provide a variably select elevation of the longitudinally extending railing.

Regarding claim 8, given the improvement as recited in claim 1 above or the apparatus as recited in claim 18 below, the method is inherently performed when the

improvement or the apparatus is assembled. Therefore, Case discloses a method for providing a barrier having at least one longitudinally extending railing supportably fastened to vertically extending posts, comprising:

- providing at least one longitudinally extending railing having at least one generally T-shaped channel extending in the longitudinal direction of the railing;

- providing vertically extending posts having an elongated body and having at least two flange segments extending outwardly in opposite direction and having at least one perforation in each flange segment;

- slidably fastening to the vertical post the T-shaped channel and through a perforation in the flange segment; and,

- providing a variably select elevation of the longitudinally extending railing.

Regarding claims 2, 9 and 19, the T-shaped channel **86** has an inwardly extending tab **A12** at an end of a leg **A13** of the channel **86**.

Regarding claim 18, Case discloses in Figures 1-3 an apparatus comprising a barrier **32**. The barrier **32** has at least one longitudinally extending railing **82**, vertically extending posts **56**, and fastening means **42c**.

The railing **82** has at least one generally T-shaped channel **86**. The channel **86** extends in a longitudinal direction **A3** of the railing **82** and at least one leg **A12** of the channel **86** extends inwardly within the channel **86**.

The posts **56** each have an elongated body **A5** and at least two flange segments **58**. The flange segments **58** extend outwardly in opposite directions **A7** and have at least one perforation **71** in each of the flange segments **58**.

The fastening means **42c** are slidably embraced within the channel **86** and the fastening means **42c** extend through the perforation **71** in the flange segments **58** and fastened to the posts **56** to provide a variably select elevation of the longitudinally extending railing.

Regarding claims 3, 10 and 20, the railing **82** has another T-shaped channel **90** thereby the railing **82** has at least two T-shaped channels **86,90**.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4, 5, 7-9, 11, 12, 14-18, 19, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMullin, 3,258,250 (see marked-up attachments provided on last office action), in view of Case, 3,388,892.

Regarding claim 1, McMullin discloses an improvement comprising at least one longitudinally extending railing **37**, vertically extending posts **11**, and fastening means **34**.

The railing **37** has at least one generally T-shaped channel **A2**. The channel **A2** extends in a longitudinal direction **A3** of the railing **37** and at least one leg **45** of the channel **A2** extends inwardly within the channel **A2**.

The posts **11** each have an elongated body **14** and at least two flange segments **A6**. The flange segments **A6** extend outwardly in opposite directions **A7** and have at least one perforation **32** in at least one of the flange segments **A6** (Fig. 1; attachment).

The fastening means **34** are slidably embraced within the channel **A2** and the fastening means **34** extend through the perforation **32** in the flange segments **A6** and fastened to the posts **11**. However, McMullin does not show another perforation in the other one of the flange segments **A6** thereby making each of the flange segments **A6** having at least one perforation to connect the rail. Case teaches in Figure 7 at least one perforation **71** in each flange segment **58** to connect a rail to a post. Therefore, as taught by Case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include at least one perforation **32** in each of the flange segments **A6** to connect the rail to the posts to provide a variably select elevation of the longitudinally extending railing.

Regarding claims 2, 9 and 19, the T-shaped channel **86** has an inwardly extending tab **45** at an end of a leg **41** of the channel **A2**.

Regarding claims 4, 11 and 22, the railing **37** has a T-shaped channel **A11**.

Regarding claims 5 and 12, the flange segments **A6** extend at 180 degrees angle to each other.

Regarding claim 8, given the modification of the improvement as recited in claim 1 above or the modification of the apparatus as recited in claim 18 below, the method is inherently performed when the improvement or the apparatus is assembled. Therefore, McMullin, as modified, discloses a method for providing a barrier having at least one longitudinally extending railing supportably fastened to vertically extending posts, comprising:

- providing at least one longitudinally extending railing having at least one generally T-shaped channel extending in the longitudinal direction of the railing;

- providing vertically extending posts having an elongated body and having at least two flange segments extending outwardly in opposite direction and having at least one perforation in each flange segment;

- slidably fastening to the vertical post the T-shaped channel and through a perforation in the flange segment; and,

- providing a variably select elevation of the longitudinally extending railing.

Regarding claim 18, McMullin discloses in Figures 1 and 3 an apparatus comprising a barrier **36**. The barrier **36** has at least one longitudinally extending railing **37**, vertically extending posts **11**, and fastening means **34**.

The railing **37** has at least one generally T-shaped channel **A2**. The channel **A2** extends in a longitudinal direction **A3** of the railing **37** and at least one leg **45** of the channel **A2** extends inwardly within the channel **A2**.

The posts **11** each have an elongated body **14** and at least two flange segments **A6**. The flange segments **A6** extend outwardly in opposite directions **A7** and have at least one perforation **32** in each of the flange segments **A6**.

The fastening means **34** are slidably embraced within the channel **A2** and the fastening means **34** extend through the perforation **32** in the flange segments **A6** and fastened to the posts **11** to provide a variably select elevation of the longitudinally extending railing.

Regarding claims 7 and 24, McMullin, as discussed above, discloses the railing **37** and the posts **11** are formed from metal (col. 1, lines 11-17). However, McMullin fails to disclose the metal being aluminum by an extrusion process. Applicant is reminded that, within the general skill of a worker in the art, selecting a known material on the basis of its suitability for the intended use is a matter of obvious design choice. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the railing and the vertical post from aluminum. *In re Leshin*, 125 USPQ 416. Furthermore, applicant is reminded that the method of forming

the railing and the posts by an extrusion process is not germane to the issue of patentability of the device itself. Therefore, this limitation has been given limited patentable weight. See MPEP ' 2113.

Regarding claims, 14-17, it is well known in the art to make a railing, posts or both by an extrusion process.

Response to Arguments

Applicant's arguments filed 3/22/04 have been fully considered but they are not persuasive.

In respect to Case, applicant has argued that the T-shaped channel apparatus and method as required are not taught in Case. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

In respect to McMullin, applicant has argued that the posts 11 do not provide specialized flange segments and specialized perforations as required. Applicant should reconsider McMullin as I-beam 11 (the post) has flange segments and at least one flange segment has a hole (perforation). From the look of McMullin, there is no way of

knowing whether the perforations are on either side of the beam 14 and the examiner relied on the teaching of Figure 7 of Case to see a connection of a rail to an I-beam post. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Furthermore, in response to applicant's arguments against case individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure. British patent, GB-1,396,301 shows a similar improvement in a barrier and a method of providing a barrier.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 9:30-6:00. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

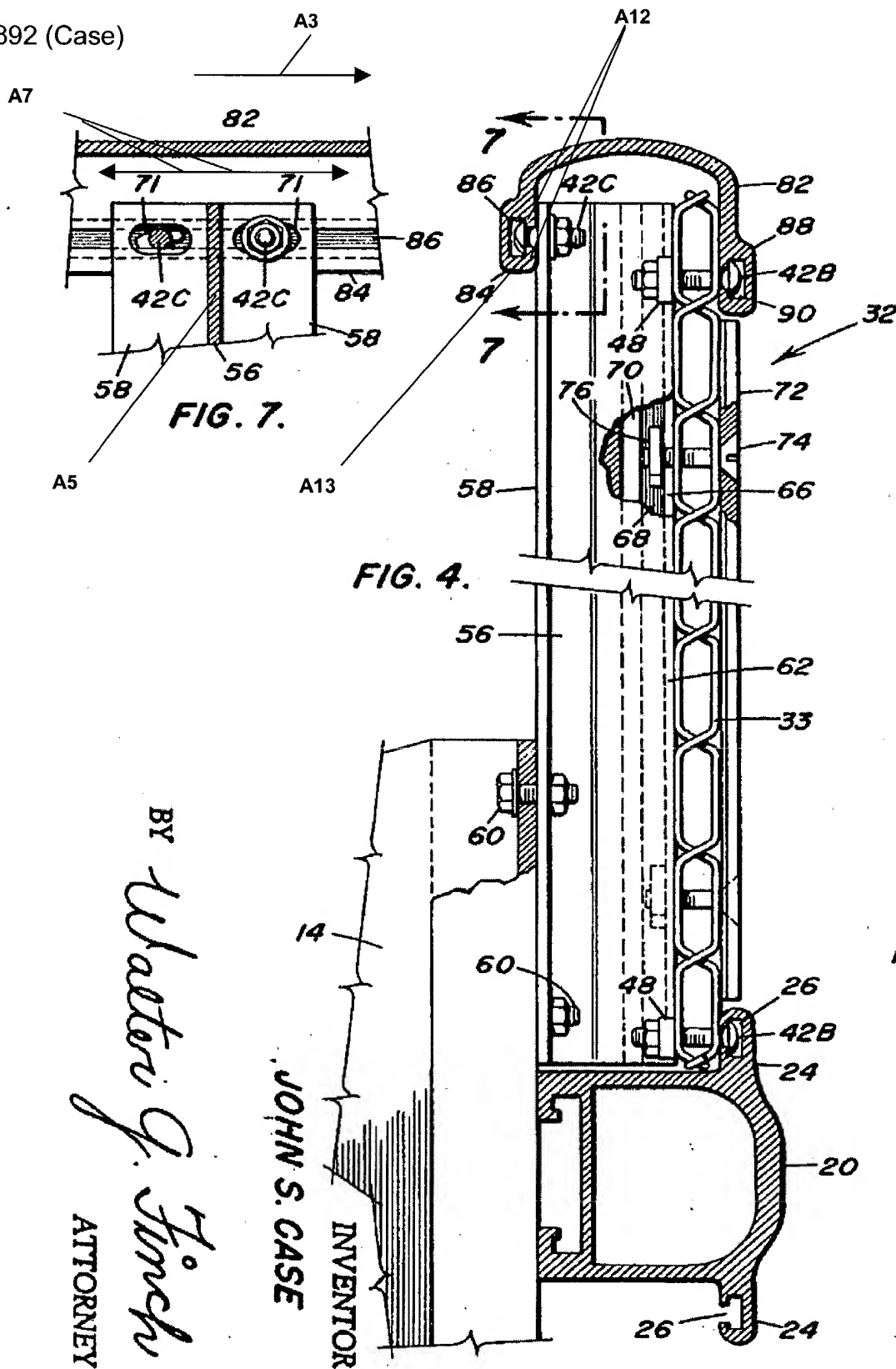
E.G.

May 11, 2004

Attachments: one marked-up copy of Case, 3,388,892; and,
one marked-up copy of McMullin, 3,258,250.

Art Unit: 3679

3,388,892 (Case)



BY
Walter G. Finch
ATTORNEY

JOHN S. CASE
INVENTOR

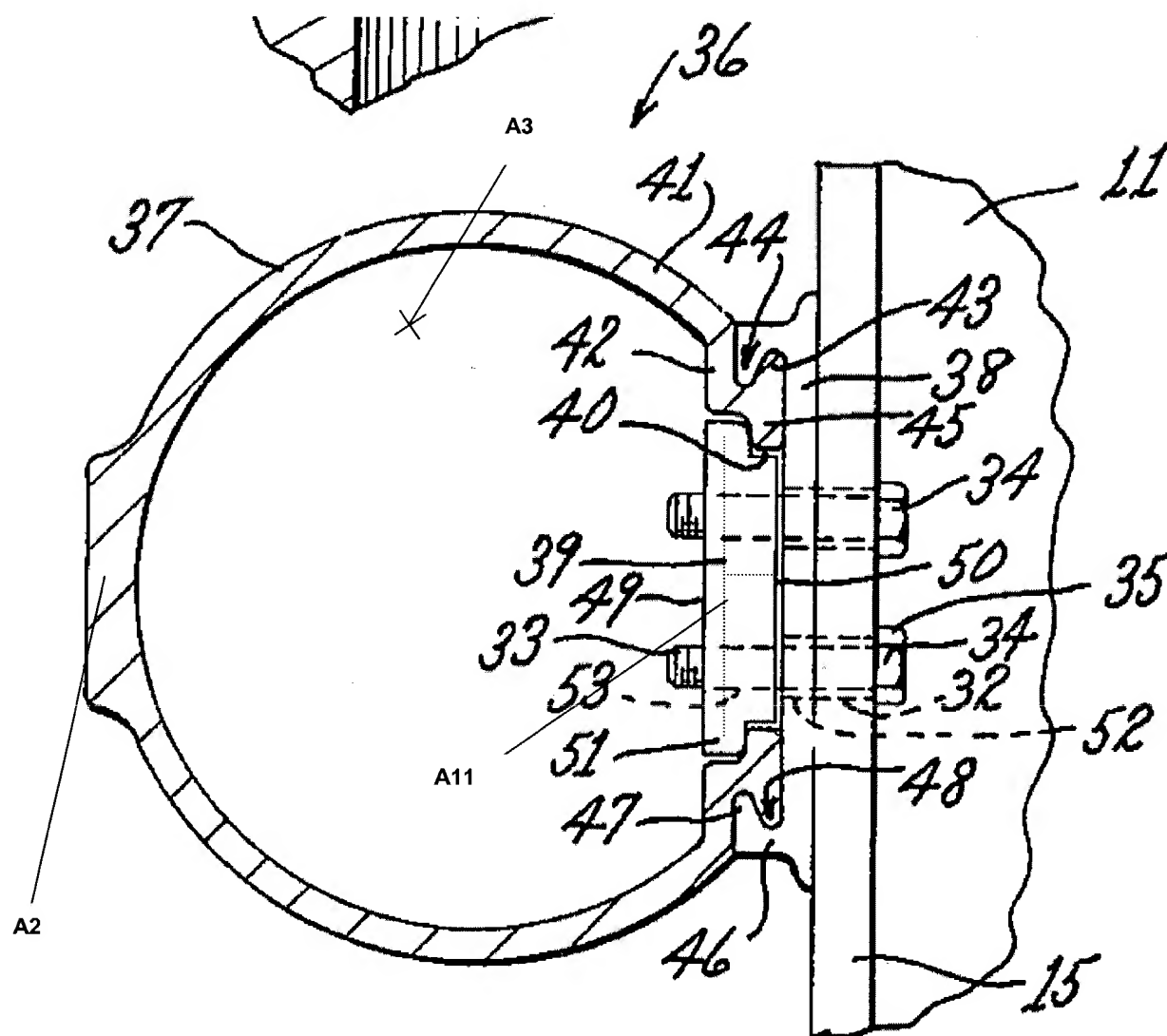


FIG. 3